

Serial No.: 10/524,301

Confirmation No.: 6371

Filed: October 11, 2005

For: PREPARATIONS BASED ON AZIRIDINO POLYETHERS AND THE USE THEREOF

Remarks

The Office Action mailed October 5, 2010 has been received and reviewed. Claims 15, 21-22, 24, 26, and 28-29 having been amended, claims 30-33 having been canceled herein without prejudice, and no claims having been added herein, the pending claims are claims 15-29.

Independent claims 15, 21, 28, and 29 have been amended to recite a catalyst component K comprising an initiator selected from the group consisting of an oxonium salt, an ammonium salt, a sulfonium salt, p-toluenesulfonic acid, zinc salt of p-toluenesulfonic acid, dodecylbenzenesulfonic acid salt, and combinations thereof. The amendment is supported by the specification at, for example, page 23, lines 10-13 (paragraph [0113] of US 2006/0106127 A1), page 24, lines 14-18 (paragraph [0119] of US 2006/0106127 A1), page 29, line 16 (paragraph [0154] of US 2006/0106127 A1), page 31, line 1 (paragraph [0158] of US 2006/0106127 A1), page 31, line 10 (paragraph [0160] of US 2006/0106127 A1), and page 32, line 1 (paragraph [0162] of US 2006/0106127 A1).

Independent claims 15, 21, 28, and 29 have also been amended to incorporate the subject matter of dependent claims 30-33 (now canceled).

Dependent claims 22, 24, and 26 have been amended to be in proper form to ultimately refer back to claim 15 (as amended).

Reconsideration and withdrawal of the rejections are respectfully requested.

Rejections under 35 U.S.C. §103(a)

The Examiner rejected claims 15-33 under 35 U.S.C. §103(a) as being unpatentable over Zech et al. (WO 01/17483), with U.S. Patent No. 6,894,144 being used as the English language translation for Examination purposes. Claims 30-33 having been canceled, Applicants respectfully traverse the rejection of claims 15-29 (as amended).

The Examiner acknowledged that "Zech *et al.* does not disclose an embodiment containing a mixture of polyether compounds which carry at least two aziridino groups {corresponding to instant formula Z1} and only 1 aziridino group {corresponding to instant

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formula Z2}" (page 3, lines 6-8; page 6, lines 11-13; page 8, lines 4-6; and page 9, lines 18-20 of the Office Action mailed October 5, 2010).

The Examiner further acknowledged that "Zech *et al.* does not specifically disclose about 0.4 wt% to about 25 wt% of polyethers having 1 aziridino group {corresponding to instant formula Z2} (page 4, lines 1-2; page 7, lines 6-7; page 8, lines 20-21; and page 10, lines 12-13 of the Office Action mailed October 5, 2010).

Additionally, independent claims 15, 21, 28, and 29 have been amended to recite a catalyst component K comprising an initiator selected from the group consisting of an oxonium salt, an ammonium salt, a sulfonium salt, p-toluenesulfonic acid, zinc salt of p-toluenesulfonic acid, dodecylbenzenesulfonic acid salt, and combinations thereof.

In contrast, Zech *et al.*, which discloses compositions having boric acid complexes as the catalyst component, fails to teach or suggest compositions having an initiator selected from the group consisting of an oxonium salt, an ammonium salt, a sulfonium salt, p-toluenesulfonic acid, zinc salt of p-toluenesulfonic acid, dodecylbenzenesulfonic acid salt, and combinations thereof.

In fact, Zech *et al.* even teaches disadvantages encountered using sulfonium salts (e.g., column 1, lines 45-47 of U.S. Patent No. 6,894,144 B1), strong acids (e.g., column 1, lines 48-50 of U.S. Patent No. 6,894,144 B1), and other known starter substances (e.g., column 1, lines 51-54 of U.S. Patent No. 6,894,144 B1). Thus, Applicants respectfully submit that Zech *et al.* teaches away from the presently claimed invention, leading one in a direction divergent from the path that was taken by the applicant. "[A] reference that 'teaches away' from a given combination may negate a motivation to modify the prior art to meet the claimed invention. . . . A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *Ormco Corp. v. Align Technology Inc.*, 79 U.S.P.Q.2d 1931, 1938 (Fed. Cir. 2006).

For at least these reasons, Applicants respectfully submit that one of skill in the art would lack the necessary motivation to modify Zech *et al.* in all of the aspects discussed herein above to arrive at the presently claimed invention. Thus, Applicants respectfully submit that the

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Examiner has failed to establish a *prima facie* case of unpatentability for claims 15-29 (as amended) being obvious over Zech et al.

Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) are respectfully requested.

Summary

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives at the telephone number listed below if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

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November 22, 2010

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that this paper is being transmitted via the U.S. Patent and Trademark Office electronic filing system in accordance with 37 CFR §1.6(a)(4) to the Patent and Trademark Office addressed to the Commissioner for Patents, Mail Stop AF, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22nd day of November, 2010.

By: 

Name: Dani Moroz
